

REMARKS

This responds to the Office Action mailed on August 23, 2005.

Claims 8, 11-13 and 20-22 have been amended. No claims have been canceled, or added. As a result, claims 1-24 are pending in this application.

The amendments to the claims are fully supported by the specification as originally filed, and no new matter will be added by entry of the amendment. The amendments to the claims are made to satisfy Applicants' preferences, not necessarily to satisfy any legal requirement(s) of the patent laws. The amendments clarify the claims and are not intended to limit the scope of equivalents to which any claim element may be entitled. Applicant respectfully requests reconsideration of the above-identified application in view of the amendments above and the remarks that follow.

§102 Rejection of the Claims

Claim 1 was rejected under 35 U.S.C. § 102(e) for anticipation by Childers et al., U.S. 6,623,785 ("Childers"). Applicant respectfully traverses this rejection.

The rule under 35 U.S.C. §102 is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference". *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP §2131.

Childers recites:

An apparatus and method for manufacturing a pharmaceutical dose which dispenses a variable selectable quantity of at least one pharmaceutical onto a pharmaceutical receiving medium. The quantity of the dispensed pharmaceutical(s) are controllably dispensed to customize each pharmaceutical dose to suit the needs of a particular user. The apparatus is coupled by an external telecommunication network to a remote signal source for receiving pharmaceutical quantity and type data for custom manufacturing a pharmaceutical dose. In one aspect, a replaceable cartridge contains a reservoir carrying at least one pharmaceutical component and a fluid drop generator which is mountable in the fluid dispenser. The reservoir may contain a number of separate compartments, each carrying different pharmaceutical component. *Childers, Abstract.*

Further, Childers recites a barrier material dispensed from a *different* reservoir:
Next, a different subgroup of heads in the head array 24 are activated by the controller 12 to dispense droplets 38 *from a different reservoir 18, 20, or 22, as shown in FIG. 2C* [sic], over the first dispensed pharmaceutical on the medium 26. This second component can be a barrier material, such as a clear coat or other inert material which will not interact with the first dispensed pharmaceutical component. The droplets 38 harden or dry to form a barrier layer 40 over the first dispensed droplets 36 and, possibly, over the entire exterior surface of the medium 26. *Childers, Col. 10, lines 20-29, emphasis added.*

The Action fails to show that Childers teaches all of the elements recited in independent claim 1. For example, the Action fails to show that Childers teaches “wherein the fluid pharmaceutical components include a vehicle that substantially evaporates from the receiving medium.” Further, because the Action fails to show that Childers teaches the fluid pharmaceutical components including “a vehicle that substantially evaporates from the receiving medium,” Childers simply cannot be relied upon to teach “an active pharmaceutical ingredient with a solubility of at least about 30 mg/ml *in the vehicle*” (emphasis added).

For the above reasons, claim 1 should be found to be allowable over Childers, and Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. §202(e) as anticipated by Childers be withdrawn.

§103 Rejection of the Claims

Claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolfe et al. (U.S. 4,533,348) in view of Childers. Applicant respectfully traverses this rejection.

Applicants respectfully submit that Childers is not prior art with respect to Applicants' claimed subject matter for the reason set forth in the following section.

Common Ownership of Present Application and U.S. Pat. No. 6,623,785 (Childers)

The present application and U.S. Pat. No. 6,623,785 were, at the time the invention of the present application was made, owned by Hewlett-Packard Development Company, L.P..

Applicant asserts the applicability of 35 U.S.C. 103(c), which is set forth immediately below:

(c) Subject matter developed by another person which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicant asserts that the Childers reference is disqualified as prior art against Applicant's claims in any obviousness rejection under 35 U.S.C. 103.

Accordingly, Applicant requests that the rejection of claims 1-24 as unpatentable under 35 U.S.C. 103(a) over Wolfe in view of Childers be withdrawn.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (352) 373-8804 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 08-2025.

Respectfully submitted,

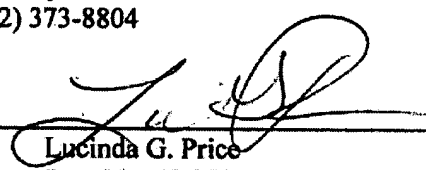
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Date Nov. 23, 2005

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23 day of November, 2005.

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